



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,853	09/22/2006	Peter Woeffen	7347-000012/US/NP	5766
27572	7590	01/09/2008		
HARNES, DICKEY & PIERCE, P.L.C.			EXAMINER	
P.O. BOX 828			BITAR, NANCY	
BLOOMFIELD HILLS, MI 48303				
			ART UNIT	PAPER NUMBER
			2624	
			MAIL DATE	DELIVERY MODE
			01/09/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/593,853

Applicant(s)

WOEFFEN ET AL.

Examiner

Nancy Bitar

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/22/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The drawings are objected to because figure 1 does not comply with 37 CFR 1.84(o) where suitable descriptive legends may be used subject to approval by Office, or may be required by the examiner where necessary for understanding of the drawing. They should contain as few words as possible. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundblad et al. ( US 6,598,726) in view of Johnston et al ( US 5,987,431) .

As to claim 1 , Lundblad teaches the method for identifying the depositor of suspicious banknotes at an automatic teller machine, wherein the deposited banknotes are subjected to an authenticity test in the automatic teller machine and classified into authentic, forged and unsuspicious banknotes depending on the result of the authenticity test( the detector means 11 is placed in the close proximity of the deposit compartment 10 and is adapted to sort false banknotes, poor quality banknotes and other banknote from the arriving banknotes, column 2, lines 10-21) , and wherein the suspicious banknotes are subjected to a further test outside of the automatic teller machine( figure 2 illustrates the stacker device 16 and the packaging device 18 in positions in which they form the unit 16-18 for storing and packaging suspected false banknotes , column 3, lines 16-32), characterized in that at least those banknotes which are classified as suspicious are provided with an imprint in the automatic teller machine ( a printing device 181 is provided for printing directly on the inner surface of packaging material( the plastic strip, column 3, lines 17-49), said imprint allowing the definitive assignment of the banknote to a specific transaction (printing unit for printing customer

information and information relating to the suspect banknotes on an inner surface of said transparent packaging material in conjunction with operation of said packaging unit to encase and seal said suspect banknotes, figure 1). While Lundbland meets a number of the limitations of the claimed invention, as pointed out more fully above, Lundbland fails to specifically teach that the suspicious banknote s are subjected to further test outside of the automatic teller machine. Specifically, Johnston et al. teaches the A printer 68, connected to the data processing means 24, prints on the tape portion 60' of the bundle 66 a deposit serial number, and the date and the transaction time. The latter two pieces of information are obtained from a clock 70 built into the data processing means 24. At the same time, the data processing means 24 causes a journal printer 72 (see FIG. 2) to print out the same details along with the card and account number of the user as read from the user's card that was inserted into the card reading slot 32. After the identifying information is printed on the bundle 66, the bundle 66 is deposited in a rejection bin 74. The binding of the rejected note or notes in a manner described effectively segregates such note or notes from the other notes rejected in the course of the other deposit transactions and held in bundles in the rejection bin 74. By comparing the information printed on each bound bundle with the journal printout, the financial institution owning the terminal 10 can track down one or more notes rejected in a transaction deposit to a particular user, and can thereby reconcile each deposit transaction. It would have been obvious to one of ordinary skill in the art to retest the notes that were rejected by the validator 26 in Lundblad processing unit in order to increase the safety and efficiency of the operation of the deposit terminal with less time. Therefore, the claimed invention

would have been obvious to one of ordinary skill in the art at the time of the invention by applicant.

As to claim 2 , Lundblad teaches the method as claimed in claim 1, wherein the imprint is made using an ink which is invisible to the human eye ( inner surface of the transparent packaging , column 4, lines 1-20, note that the information is durable and difficult to manipulate unnoticed) .

As to claim 3 , Lundblad teaches the method as claimed in claim 1, wherein the identification data of the automatic teller machine and the data, including date and time, which characterizes the transaction are printed (Any suspect banknotes encountered in the detector device 11 can be transported to the stacker device 16 for instance, and from there to the packaging unit 18 where they are packaged together with an automatically printed receipt that includes the number of banknotes, the date, etc., and also information relating to the customer depositing the banknotes, e.g. through the medium of an account number. This enables the source of false or suspect banknotes to be investigated, column 3, lines 6-16,). Moreover, Johnston et al also teaches that a printer 68, connected to the data processing means 24, prints on the tape portion 60' of the bundle 66 a deposit serial number, and the date and the transaction time. The latter two pieces of information are obtained from a clock 70 built into the data processing means 24. At the same time, the data processing means 24 causes a journal printer 72 (see FIG. 2) to print out the same details along with the card and account number of the user as read from the user's card that was inserted into the card reading slot 32)

As to claim 4, Johnston teaches the method as claimed in claim 2, wherein the data is printed onto the note in the form of a barcode ( see figure 5).

Claims 5-7 differ from claims 1-4 only in that claims 1-4 are method claims whereas, claims 4-7 are apparatus claims. Thus, claims 5-7 are analyzed as previously discussed with respect to claims 1-4 above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nancy Bitar whose telephone number is 571-270-1041. The examiner can normally be reached on Mon-Fri (7:30a.m. to 5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on 571-272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

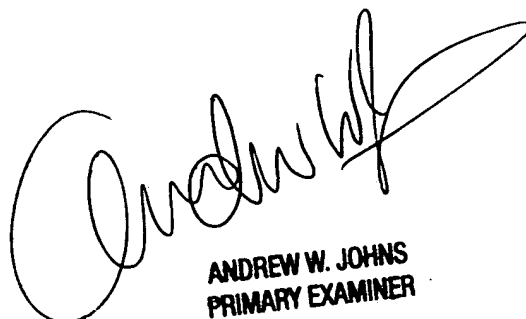
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number:  
10/593,853  
Art Unit: 2624

Page 7

Nancy Bitar

1/3/2008



ANDREW W. JOHNS  
PRIMARY EXAMINER